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OFFICE OF PETITIONS

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In re Application of :
Hidekazu Watanabe et al. :
Application No. 08/764,394 : DECISION ON PETITION
Filed: December 11, 1996 : UNDER 37 C.F.R. §1.137(b)
Attorney Docket Number: :
7217/52300 :
Title: TELEPHONE APPARATUS USED :
FOR COMPUTER NETWORK TELEPHONE :
SYSTEM :

This is a decision on the petition, filed on June 12, 2006, pursuant to 37 C.F.R. §1.137(b)¹, to revive the above-identified application.

The above-identified application became abandoned for failure to submit the issue fee in a timely manner in reply to the Notice of Allowance and Issue Fee Due, mailed December 17, 1999, which set a shortened statutory period for reply of three months. No

¹ A grantable petition pursuant to 37 C.F.R. §1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional, and;
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

extensions of time are permitted for transmitting issue fees². Accordingly, the above-identified application became abandoned on March 18, 2000. A Notice of Abandonment was mailed on June 29, 2000.

Almost six years later, the present petition was filed, along with the petition fee and a statement of facts. Petitioner has met the first and second requirements of Rule §1.137(b). The fourth requirement is not applicable.

Regarding the third requirement, Petitioner has not established that the entire period of delay was unintentional. It is noted that almost six years passed between the mailing of the notice of abandonment and the filing of the present petition.

Petitioner asserts that "on or about December 9, 2005³," Applicant requested the law firm of Cooper and Dunham to transfer the present file to Petitioner's law firm. The present petition was not filed until June 12, 2006. It is not clear why a registered practitioner would wait more than six months after the file was requested before filing this petition and the issue fee.

Petitioner has asserted that the notice of abandonment was located in the file, along with a letter dated December 14, 1999, signed by Mr. Maioli (an attorney at Cooper and Dunham and the former attorney of record) and sent to the applicant's General Manager, where Mr. Maioli indicated that a notice of allowance would be forthcoming. Petitioner further located the following items in the file:

- an unsigned letter from Mr. Maioli to the applicant's General Manager concerning the abandonment;
- an unsigned draft petition dated January 18, 2001;
- an unsigned declaration of Mr. Maioli;
- an unsigned declaration of Mr. Dunn (the man responsible for the docketing department at Cooper and Dunham);
- an unsigned declaration of Mr. Breland (the man in charge of the mailroom at Cooper and Dunham);
- two unsigned checks from Cooper and Dunham to the PTO for the petition and issue fees;
- a postcard, and;
- a draft petition dated December 13, 2001.

² See MPEP §710.02(e).

³ Petition, page 1.

Petitioner has asserted that each of these bulleted items was "loosely contained in the file, i.e. they were not bound into the file jacket⁴." The significance of the fact that these papers were not secured to the file jacket, if any, is not appreciated by the undersigned.

As such, it appears that at some point, Mr. Maioli might have intended to file a petition with the Office to seek the revival of this application, but for unknown reasons, never signed or filed this petition.

It is noted in passing that Petitioner has asserted that the unsigned petition that has been found in the file was incorrectly titled as "unavoidable delay" rather than "unintentional delay⁵." It is not clear what would cause Petitioner's representative to arrive at the conclusion that the title of the petition was incorrect: it is noted that the petition contains a statement of *unavoidable* delay, and makes reference to a check in the amount of \$110, which at the time was the fee associated with the filing of a petition to revive under the unavoidable standard.

As discussed above, Petitioner has submitted non-executed declarations from Messrs. Maioli, Dunn, and Breland, presumably to attempt to establish that the notice of allowance and issue fee due was not received by the law firm of Cooper and Dunham. However, none of these declarations can be accepted, since none has been executed. See 37 C.F.R. §1.4 and MPEP §502.02.

Moreover, it is not clear why both the Applicant and former counsel chose to take no course of action for such a long period of time. It does not appear that either the Applicant or any member of Cooper and Dunham took any action to further the prosecution of this application⁶. It seems that it would be unreasonable for either an applicant or their representative to mail or receive a letter which indicated that a notice of allowance and issue fee due was soon expected from the Office, and after not receiving any correspondence from the Office for an extended period of time, not realize that something had gone amiss.

⁴ Id. at 2.

⁵ Petition, page 4.

⁶ Cooper and Dunham prepared declarations and drafted a petition, however none of these documents was either signed, or submitted to the Office. As such, no action was undertaken by Cooper and Dunham that was reasonably apprised to seek the revival of this application.

It is equally unclear what, after all of this time, prompted the Applicant to advance the prosecution of this application.

As such, it appears that both the Applicant and his attorney(s) intentionally allowed this application to go abandoned.

The extended inaction of the members of Cooper and Dunham, the Applicant, and current counsel appears to be intentional, and Petitioner does not appear to have submitted a statement of facts from any member of Cooper and Dunham⁷ or the Applicant which would assert a contrary position.

In order for a petition under 37 C.F.R. §1.137(b) to be granted, the holder of the rights to the application must have unintentionally allowed the application to go abandoned, and a delay resulting from a deliberately chosen course of action on the part of the applicant is not an "unintentional" delay within the meaning of 37 C.F.R. §1.137(b).

The periods of delay:

There are three periods to be considered during the evaluation of a petition under 37 CFR 1.137(b):

- (1) the delay in reply that originally resulted in the abandonment;
- (2) the delay in filing an initial petition pursuant to 37 C.F.R. §1.137(b) to revive the application; and
- (3) the delay in filing a grantable petition pursuant to 37 C.F.R. §1.137(b) to revive the application.

Currently, the delay has not been shown to the satisfaction of the Director to be unintentional for periods (1), (2), or (3).

As to Period (1), the patent statute at 35 U.S.C. § 41(a)(7) authorizes the Director to revive an "unintentionally abandoned application." The legislative history of Public Law 97-247 reveals that the purpose of 35 U.S.C. § 41(a)(7) is to permit the Office to have more discretion than in 35 U.S.C. §§ 133 or 151 to revive abandoned applications in appropriate circumstances, but places a limit on this discretion, stating that "[u]nder this section a petition accompanied by either a fee of \$500 or a fee of \$50 **would not be granted where the abandonment or the failure to pay the fee for issuing the patent was intentional** as opposed to being unintentional or

⁷ Statements from members of Cooper and Dunham have been submitted, however as discussed above, they cannot be accepted.

unavoidable." [emphasis added]. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6-7 (1982), *reprinted in* 1982 U.S.C.C.A.N. 770-71. The revival of an intentionally abandoned application is antithetical to the meaning and intent of the statute and regulation.

35 U.S.C. § 41(a)(7) authorizes the Commissioner to accept a petition "for the revival of an unintentionally abandoned application for a patent." As amended December 1, 1997, 37 CFR 1.137(b)(3) provides that a petition under 37 CFR 1.137(b) must be accompanied by a statement that the delay was unintentional, but provides that "[t]he Commissioner may require additional information where there is a question whether the delay was unintentional." Where, as here there is a question whether the initial delay was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). See In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989); 37 CFR 1.137(b). Here, in view of the inordinate delay of more than six years in resuming prosecution, there is a question whether the entire delay was unintentional. Petitioner should note that the issue is not whether some of the delay was unintentional by any party; rather, the issue is whether the entire delay has been shown to the satisfaction of the Director to be unintentional.

The question under 37 CFR 1.137(b) for period (1) is whether the delay on the part of the party having the right or authority to reply to avoid abandonment (or not reply) was unintentional. Accordingly, any renewed petition must clearly identify the party having the right to reply to avoid abandonment. That party, in turn must explain what effort(s) was made to reply to the outstanding Office action and further, why no reply was filed. If no effort was made to reply, then that party must explain why the delay in this application does not result from a deliberate course of action (or inaction). Likewise, as the law firm of Cooper and Dunham was counsel of record at the date of abandonment, an individual from Cooper and Dunham should explain why this application became abandoned while it was under their control and what efforts Cooper and Dunham made to advance the prosecution of this application, and with whom this matter was discussed outside of Cooper and Dunham. Petitioner has provided a copy of one piece of correspondence relating to the failure to file the issue fee in a timely manner. Are there any others present in the file from whoever else was involved with this application at the time of abandonment? Statements are required from any and all persons then at Cooper and Dunham, and the

responsible person(s) having firsthand knowledge of the circumstances surrounding the lack of a reply to the outstanding Office action (such as Mr. Maioli). As the courts have made clear, it is pointless for the USPTO to revive a long abandoned application without an adequate showing that the delay did not result from a deliberate course of action. See Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005); Lumenyte Int'l Corp. v. Cable Lite Corp., Nos. 96-1011, 96-1077, 1996 U.S. App. LEXIS 16400, 1996 WL 383927 (Fed. Cir. July 9, 1996) (unpublished) (patents held unenforceable due to a finding of inequitable conduct in submitting an inappropriate statement that the abandonment was unintentional).

Petitioner has set forth that "the previous attorney, Jay H. Maioli, is no longer employed with the firm of Cooper and Dunham LLP and therefore is not available to provide any further information⁸." However, it does not appear that Petitioner has made any effort to contact this individual in order to seek the obtainment of a statement of facts from the same. Furthermore, it is not clear why Mr. Maioli is the only individual who could provide information pertaining to Cooper and Dunham's inaction.

As to Period (2), where the applicant deliberately chooses not to seek or persist in seeking the revival of an abandoned application, or where the applicant deliberately chooses to delay seeking the revival of an abandoned application, the resulting delay in seeking revival of the abandoned application cannot be considered as "unintentional" within the meaning of 37 C.F.R. §1.137(b)⁹.

The language of both 35 USC 41(a)(7) and 37 CFR 1.137(b) are clear and unambiguous, and furthermore, without qualification. That is, the delay in filing the reply during prosecution, as well as in filing the petition seeking revival, must have been, without qualification, "unintentional" for the reply to now be accepted on petition. The Office requires that the entire delay be at least unintentional as a prerequisite to revival of an abandoned application to prevent abuse and injury to the public. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 7 (1982), reprinted in 1982 U.S.C.C.A.N. 771 ("[i]n order to prevent abuse and injury to the public the Commissioner . . . could require applicants to act promptly after becoming aware of the

⁸ Petition, page 2.

⁹ See MPEP 711.03(c).

abandonment"). The December 1997 change to 37 CFR 1.137 did not create any new right to overcome an intentional delay in seeking revival, or in renewing an attempt at seeking revival, of an abandoned application. See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53160 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 87 (October 21, 1997), which clearly stated clear that any protracted delay (here, six years) could trigger, as here, a request for additional information. As the courts have since made clear, a protracted delay in seeking revival, as here, requires a petitioner's detailed explanation seeking to excuse the delay as opposed to USPTO acceptance of a general allegation of unintentional delay. See Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633, at 1637-8 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005) at *21-*23. Statements are required from any and all persons then at Cooper and Dunham, and the responsible person(s) (such as Mr. Maioli) having firsthand knowledge of the circumstances surrounding the protracted delay, after the abandonment date, in seeking revival.

Moreover, the presence of declarations and a petition to revive which were prepared, but neither executed nor submitted to the Office, appears to constitute evidence that a conscious decision was made not to seek the revival of this application.

As to Period (3), it is not clear when the present law firm of record received the present file. Petitioner has set forth that "upon receipt of the file, the undersigned attorneys promptly reviewed the file and determined that he application had been abandoned..."¹⁰ It is noted that the Applicant requested Cooper and Dunham to transfer the file to Petitioner on or about December 9, 2005, and that the present petition was not filed until more than six months later - before it can be determined if the present law firm of record acted in a diligent manner, it must first be revealed when the present law firm of record received the file.

Punctuality and Due Diligence:

For more than a century, punctuality and due diligence, equally with good faith, have been deemed essential requisites to the success of those who seek to obtain the special privileges of the patent law, and they are demanded

¹⁰ Petition, page 1.

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in the interest of the public and for the protection of rival inventors. See: Porter v. Loudon, 7 App.D.C. 64 (C.A.D.C. 1895), citing Wollensak v. Sargent, 151 U.S. 221, 228, 38 L. Ed. 137, 14 S. Ct. 291 (1894).

Similarly, an invention benefits no one unless it is made public, and the rule of diligence should be so applied as to encourage reasonable promptness in conferring this benefit upon the public. Automatic Electric Co. v. Dyson, 52 App. D.C. 82; 281 F. 586 (C.A.D.C. 1922). Generally, 35 U.S.C. §6; 37 C.F.R. §§1.181, 182, 183.

The lengthy period of inaction does not appear to be consistent with the requirements of punctuality, due diligence, good faith, and the encouragement of reasonable promptness.

On renewed petition, Petitioner will need to address each of these issues, if it is to be established that the entire period of delay was not intentional.

Petitioner is reminded that any statement of facts should be made by one having firsthand knowledge of the facts set forth therein.

Pursuant to the discussion above, the petition is **DISMISSED**.

Any reply must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. 1.137(b)". This is not a final agency action within the meaning of 5 U.S.C 704.

Thereafter, there will be no further reconsideration of this matter^{11, 12}.

11 For more than a century, punctuality and due diligence, equally with good faith, have been deemed essential requisites to the success of those who seek to obtain the special privileges of the patent law, and they are demanded in the interest of the public and for the protection of rival inventors. See: Porter v. Loudon, 7 App.D.C. 64 (C.A.D.C. 1895), citing Wollensak v. Sargent, 151 U.S. 221, 228, 38 L. Ed. 137, 14 S. Ct. 291 (1894). An invention benefits no one unless it is made public, and the rule of diligence should be so applied as to encourage reasonable promptness in conferring this benefit upon the public. Automatic Electric Co. v. Dyson, 52 App. D.C. 82; 281 F. 586 (C.A.D.C. 1922). Generally, 35 U.S.C. §6; 37 C.F.R. §§1.181, 182, 183.

12 If, on the second request for reconsideration, Petitioner fails to satisfy the showings burden required: (a) the resulting decision may be one viewed as

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The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanowski, and may be submitted by mail¹³, hand-delivery¹⁴, or facsimile¹⁵.

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225¹⁶. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.



Paul Shanowski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

final agency action; and (b) provisions for reconsideration, such as those at 37 C.F.R. §1.137(e), will not apply to that decision.

13 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

14 Customer Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

15 (571) 273-8300- please note this is a central facsimile number.

16 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. §1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).